

L Number	Hits	Search Text	DB	Time stamp
15	4832	"two hybrid" or "two-hybrid" or "interaction trap"	USPAT; US-PPGPUB; EPO; JPO; DERWENT	2003/02/23 20:10
16	70	GRE or ERE or UAS same "two hybrid" or "two-hybrid" or "interaction trap"	USPAT; US-PPGPUB; EPO; JPO; DERWENT	2003/02/23 20:14
17	0	estradiol or dexamethasone same GRE or ERE or UAS same "two hybrid" or "two-hybrid" or "interaction trap"	USPAT; US-PPGPUB; EPO; JPO; DERWENT	2003/02/23 20:11
18	74	estradiol or dexamethasone same "116"	USPAT; US-PPGPUB; EPO; JPO; DERWENT	2003/02/23 20:13
19	4	estradiol or dexamethasone same ((GRE or ERE or UAS) same ("two hybrid" or "two-hybrid" or "interaction trap"))	USPAT; US-PPGPUB; EPO; JPO; DERWENT	2003/02/23 20:11
20	0	(GRE or ERE or UAS) near ("two hybrid" or "two-hybrid" or "interaction trap")	USPAT; US-PPGPUB; EPO; JPO; DERWENT	2003/02/23 20:14
21	4	(GRE or ERE or UAS) near hybrid	USPAT; US-PPGPUB; EPO; JPO; DERWENT	2003/02/23 20:15
22	2	(GRE or ERE or UAS) near fusion	USPAT; US-PPGPUB; EPO; JPO; DERWENT	2003/02/23 20:16
23	226	("steroid inducible" or "steroid-inducible") with promoter	USPAT; US-PPGPUB; EPO; JPO; DERWENT	2003/02/23 20:16
24	0	((("steroid inducible" or "steroid-inducible") with promoter) same ("two hybrid" or "two-hybrid" or "interaction trap"))	USPAT; US-PPGPUB; EPO; JPO; DERWENT	2003/02/23 20:16
25	14	((("steroid inducible" or "steroid-inducible") with promoter) and ("two hybrid" or "two-hybrid" or "interaction trap"))	USPAT; US-PPGPUB; EPO; JPO; DERWENT	2003/02/23 20:16



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APPLICATION NO	FILED DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
09-680,738	10-06-2000	David N. Edwards	HYB775-00 00381A	2494
21003	7890	02-25-2003		
BAKER & BOTT'S 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER	LOEB, BRONWEN
			ART UNIT	PAPER NUMBER
			1636	71
			DATE MAILED: 02-25-2003	

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/680,738

Applicant(s)

EDWARDS ET AL.

Examiner

Bronwen M. Loeb

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133)
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 15 November 2002.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1,2,4-6,8-10 and 17 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1,2,4-6,8 and 9 is/are rejected.

7) Claim(s) 10,11 and 17 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 09 August 2002 is/are: a) accepted or b) objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a)  The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) Notice of References Cited (PTO-892)  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 20

4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_  
5) Notice of Informal Patent Application (PTO-152)  
6) Other: \_\_\_\_\_

### **DETAILED ACTION**

This action is in response to the papers filed 15 November 2002.

The indicated allowability of claims 1, 2, 4-6, 8-10 and 17 is withdrawn in view of the newly discovered reference(s) to Dove et al. A rejection based on the newly cited reference follow.

Claims 1, 2, 4-6, 8-10 and 17 are pending.

#### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 15 November 2002 has been entered.

#### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application

by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. §102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. §102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. §102(e)).

3. Claims 1, 2, 4-6, 8 and 9 are rejected under 35 U.S.C. §102(e) as being anticipated by Dove (USP 5,925,523).

Dove teaches a two hybrid system for detecting interactions between proteins in prokaryotic cells. In one example, the first hybrid protein comprises the DNA binding domain of  $\lambda$ .cl fused to the dimerization domain of GAL4 and the second hybrid protein comprises the  $\alpha$  subunit of RNA polymerase and GAL11<sup>P</sup> which can interact with the GAL4 dimerization domain (col. 14-15). These hybrids are inducibly expressed by the addition of IPTG (which induces lac operators by binding lac repressor which causes it to no longer bind the operator thus allowing transcription). Increasing the amount of IPTG added increases the amounts of the two hybrids which results in increased expression of the detectable reporter gene,  $\beta$ -galactosidase, as is shown in Figure 2B. Thus, Dove et al teaches a two hybrid system that is continuously adjustable because it is plurally stepped dose-responsive, consistent with the definition of "continuously adjustable" taught in the specification on (p. 14, lines 23-25).

***Conclusion***

Claims 1, 2, 4-6, 8 and 9 are rejected. Claims 10, 11 and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Certain papers related to this application may be submitted to Art Unit 1636 by facsimile transmission. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). The official fax telephone numbers for the Group are (703) 308-4242 and (703) 305-3014. NOTE: If Applicant does submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bronwen M. Loeb whose telephone number is (703) 605-1197. The examiner can normally be reached on Monday through Friday, from 11:00 AM to 7:30 PM. A phone message left at this number will be responded to as soon as possible (usually no later than the next business day after receipt by the examiner).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Remy Yucel, can be reached on (703) 305-1998.

The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Bronwen M. Loeb, Ph.D.  
Patent Examiner  
Art Unit 1636

February 23, 2003

*Remy Yucel*  
REMY YUCEL, PH.D  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600